

**REMARKS**

In the final Office Action, the Examiner rejected claims 45 and 46 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,182,705 to Barr ("Barr") in further view of U.S. Patent No. 6,810,382 to Wamsley ("Wamsley"); claims 47-58 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,950,805 to Kavanaugh ("Kavanaugh") in view of U.S. Patent No. 7,343,308 to Rojewski ("Rojewski"); claims 1-2, 6, 8, 9, 13, and 16 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,096 to Jernberg ("Jernberg") in view of U.S. Patent No. 5,550,734 to Tarter ("Tarter") in further view of *Rojewski*; claims 3-5 and 10-12 under 35 U.S.C. 103(a) as being unpatentable over *Jernberg* in view of *Tarter* and *Rojewski*, and in further view of "*IRT Business This Week 2 (Fraud): Some insurance firms have paid bounties to beat fraud-Insurers say fraudulent claims cost them (pounds) 30 million last year*" (hereinafter referred to as *IRT*); claims 7 and 14 under 35 U.S.C. 103(a) as being unpatentable over *Jernberg* in view of *Tarter* and *Rojewski*, and in further view of U.S. Patent No. 5,594,638<sup>1</sup> to Iliff ("Iliff"); claims 17-30 under 35 U.S.C. 103(a) as being unpatentable over *Jernberg* in view of U.S. Patent No. 5,583,758 to McIlroy ("McIlroy") and in further view of U.S. Patent No. 5,666,492 to Rhodes ("Rhodes"); claims 31, 32, 34-39, and 41-44 under 35 U.S.C. 103(a) as being unpatentable over *Jernberg* in view of U.S. Patent No. 5,855,005 to Schuler ("Schuler") in further view of *Wamsley*; and claims 33 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Jernberg* in view

---

<sup>1</sup>The Examiner indicated 5,594,639 was a typographical error, and the correct number was 5,594,638 via telephone on December 18, 2009.

of *Schuler* and *Wamsley*, and in further view of U.S. Patent Application Publication No. 2002/0177991 to *Ejerjed* ("*Ejerjed*").

By this amendment, Applicant amends claims 1, 8, 15-17, 21-23, 29-31, 38, 45-47, 52, 57, and 58. Claims 1-5, 7-12, and 14-58 remain pending.

**I. Rejection of Claims 45 and 46 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) as being unpatentable over *Barr* in view of *Wamsley*. The Office Action fails to establish a *prima facie* case of obviousness with respect to these claims.

**a. The Office Actions Fails to Present a *Prima Facie* Case of Obviousness Regards to "means for automatically assigning the insurance claims to a litigation administrator when a litigation criteria is met by the received data"**

Independent claim 45 recites, among other things, a system from managing litigation including, among other components, "means for automatically assigning the insurance claim to a litigation administrator when a litigation criteria is met by the received data." The Office Action asserts that these features are taught by the following sections of *Barr*: 1) column 1, line 64-column 2, line 15; 2) column 3, lines 28-43; and/or 3) claim 3. However, after a thorough review of these sections, and the remainder of *Barr*, it is unclear what features of *Barr* the Examiner is alleging teach the claimed "litigation administrator," the claimed "litigation criteria . . . met by the received data," or the claimed "automatic[] assign[ment]." Indeed, in contrast to the Examiner's assertions, *Barr* discloses that "[a]fter reviewing the claim, the supervisor electronically assigns it to a particular staff member." Col. 4, lines 12-17. Accordingly, the assignments taught by *Barr* are done manually (*i.e.*, not automatically) by a supervisor. Therefore, the Office Actions assertions are either based on a mischaracterization of

*Barr* and/or based on an unreasonable interpretation of the claim, as manual in not automatic. Moreover, the Office Action fails to address this difference between the cited art and the claimed invention. *If the Examiner continues to assert that Barr teaches this element, Applicants respectfully request the Examiner specifically identify which features of Barr teach the claimed “litigation administrator,” the claimed “litigation criteria . . . met by the received data,” or the claimed “automatic[] assign[ment].”* “It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” MPEP § 706.02(j).

**b. The Office Actions Fails to Present a *Prima Facie* Case of Obviousness Regards to “means for providing a user interface . . . the user interface displays a screen comprising: . . . a third section including a list of tasks associated with the insurance claim and status of completion of the tasks”**

Independent claim 45 recites a system for managing litigation including, among other components, “means for providing a user interface . . . the user interface displays a screen comprising: . . . a third section including a list of tasks associated with the insurance claim and status of completion of the tasks,” (emphasis added). *Barr* does not teach or even suggest at least these elements of claim 45. Indeed, the Final Office Action concedes this point on page 3. Instead, the Final Office Action relies upon *Wamsley* to cure tease deficiencies of *Barr*.

*Wamsley* discloses that “[s]election of button icon 181e of menu 181 generates a daily worksheet which lists outstanding ticklers and other prompts, indicating actions that need to be taken to maintain advancement of all open client cases relative to a specified date. The scheduled generation of these ticklers and prompts to provide for

the timely and efficient advancement of a client's claim from one phase to the next is further described in connection with FIGS. 3-8. The worksheet presents the clients in alphabetical order with the outstanding action items being indicated adjacent to the client name." 18:10-20 However, *Wamsley* fails to disclose or suggest "a list of tasks associated with the insurance claim and status of completion of the tasks" at least because *Wamsley* is silent with respect to displaying a status of completion of the task. Indeed, *Wamsley* only displays "outstanding action items."

For at least these reasons, *Barr* and *Wamsley* do not teach or suggest "means for providing a user interface . . . the user interface displays a screen comprising: . . . a third section including a list of tasks associated with the insurance claim and status of completion of the tasks," as recited in claim 45(emphasis added). This difference between the cited art and the claimed invention is not addressed in the Office Action.

In view of arguments above, the Office Action fails to address several of the significant differences between the cited art and claimed invention. Therefore, the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 35. Independent claim 46, although of different scope from claim 45, recites elements similar to those set forth above for claim 45. Claim 46 is therefore allowable for reasons at least similar to those presented above with respect to claim 45. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 102(b).

## **II. Rejection of Claims 47-58 under 35 U.S.C. § 102(e)**

Applicant respectfully traverses the rejection of claims 47-58 under 35 U.S.C. § 102(e) as being anticipated by *Kavanaugh* in view of *Rojewski*. As an

initial matter, Applicant notes that they believe that the Examiner intended to rejected the claim under 35 U.S.C. § 103(a), and have responded accordingly. *Kavanaugh* and *Rojewski* fail to establish a *prima facie* case of obviousness with respect to claims 47-58.

Independent claim 47 recites a method of managing fees including, among other steps, "receiving data about a recovery of a portion of the costs paid by the insurance company for the insurance claim filed by the insured, the data including at least an amount recovered from the party and by the collector; determining taxes due on the amount of the costs paid by the insurance company recovered; and calculating a fee due to the collector based on at least one of the amount of the costs paid by the insurance company recovered and a fee schedule specified in the agreement," (emphasis added). *Kavanaugh* and *Rojewski*, alone or in combination, do not teach or even suggest at least these elements of claim 47.

*Kavanaugh* discloses:

One target of the present invention is a wealthy person who is considering the purchase of a deferred annuity or has an existing deferred annuity . . . . When they die their estate or heirs will pay state and federal income tax as well as estate tax. Instead, they could **take this deferred annuity, convert it to an immediate annuity and buy life insurance with the resulting income stream.** Where this arrangement can be properly structured, the tax-free death benefit would be paid to the heirs from what would have otherwise been substantially taxed. (Emphasis added, Col. 4, lines 29-43).

Thus, in *Kavanaugh* an insured can use an annuity to buy life insurance and the life insurance premium would be paid out to heirs of the insured when a claim is filed by the heirs. Such a disclosure, however, does not constitute the claimed method of

managing fees because *Kavanaugh* does not teach or suggest at least “paying costs to an insured in response to an insurance claim filed by the insured,” (emphasis added) as recited in claim 47. In *Kavanaugh*, the life insurance premium is paid out to the heirs and **not** to the insured, and the life insurance premium would be paid out in response to a claim filed by the heirs, and **not** by the insured. In fact, the insured would, of course, not be able to file a claim because he or she would be deceased.

Additionally, *Kavanaugh* discloses “managing tax consequences of the income within an investment trust.” This does not disclose, or even suggest, “determining taxes due on the amount of the costs paid by the insurance company recovered,” as recited in claim 47, at least because the “tax consequences of the income within an investment trust” are not, even under the broadest reasonable interpretation, “taxes dues on the amount of the costs paid by the insurance company recovered.” Indeed, the Final Office Action concedes that *Kavanaugh* does not teach paying costs to an insured in response to an insurance claim. Page 4. Accordingly, *Kavanaugh* cannot teach recovering a portion of those paid costs.

*Rojewski* fails to cure the deficiencies of *Kavanaugh*. That is, *Rojewski* also fails to disclose or suggest the aforementioned features of claim 47. *Rojewski* merely discloses valuing subrogation rights to package them as securities. Col. 2, lines 13-24. However, *Rojewski* is silent with regard to taxes.

For at least these reasons, *Kavanaugh* and *Rojewski*, alone or in combination, do not teach or suggest each and every element of claim 47. The Office Action fails to address these significant differences between the cited art and the claimed invention. Therefore, a *prima facie* case of obviousness has not been presented, and independent

claim 47 is allowable over *Kavanaugh* and *Rojewski*. Independent claims 52, 57, and 58, although of different scope from claim 47, recite elements similar to those set forth above for claim 47. Claims 52, 57, and 58 are therefore allowable for reasons at least similar to those presented above with respect to claim 47. Claims 48-51 and 53-56 are also allowable at least due to their dependence from one of independent claims 47 and 52. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 102(e).

**III. Rejection of Claims 1, 2, 6, 8, 9, 13, 15, and 16 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 1, 2, 8, 9, 15, and 16 under 35 U.S.C. § 103(a) as being unpatentable in view of *Jemberg*, *Tarter*, and *Rojewski* because a *prima facie* case of obviousness has not been established with respect to these claims.

Independent claim 1 recites a method for managing insurance claims including, among other steps “searching a client database to determine if other claims exist for an insured individual associated with the claim, wherein, if it is determined that no other claim exists for the insured individual, payment is delayed pending investigation.” *Jemberg*, *Tarter*, and *Rojewski*, alone or in combination, fail to teach, suggest, or render obvious at least these elements of claim 1.

In *Jemberg*:

[r]isk data includes liability data for the site [and] . . .  
[s]ettlement data are the insurance companies' offers of settlement and the insured's co-payment offers . . . . The settlement data is compared to the risk data and the expected normal liability for each PRP and insurer. A calculation is made to determine absolute and percentage deviation between each party's settlement position (offer or

demand) and the expected normal liability of each party. This calculation is used by the third party to determine settlement groupings and priorities. No quantitative results are provided to any party. (Col. 3, line 41 to col. 4, line 13).

Thus, in *Jernberg* risk data is compared with settlement data to determine settlement groupings and priorities. However, *Jernberg* fails to disclose or suggest “searching a client database to determine if other claims exist for an insured individual associated with the claim, wherein, if it is determined that no other claim exists for the insured individual, payment is delayed pending investigation,” as recited in claim 1.

*Tarter* and *Rojewski* do not overcome the above-noted deficiencies of *Jernberg*. That is, *Rojewski* also fails to disclose or suggest “searching a client database to determine if other claims exist for an insured individual associated with the claim, wherein, if it is determined that no other claim exists for the insured individual, payment is delayed pending investigation,” as recited in claim 1. *Rojewski* merely discloses valuing subrogation rights to package them as securities. Col. 2, lines 13-24. And, *Tarter* merely discloses a computerized method for financing healthcare providers. Abstract. However, both *Rojewski* and *Tarter* are silent with regard to aforementioned element of claim 1.

Accordingly, *Jernberg*, *Tarter*, and *Rojewski*, alone or in combination, fail to teach, suggest, or render obvious the step of “searching a client database to determine if other claims exist for an insured individual associated with the claim, wherein, if it is determined that no other claim exists for the insured individual, payment is delayed pending investigation,” as recited in claim 1. Therefore, the cited art fails to render obvious claim 1.

Independent claims 8, 15, and 16, although of different scope, contain similar recitations to those of claim 1. Therefore, the rejections of these claims under 35 U.S.C. § 103(a) is not supported by the art of record, for at least the reasons set forth above with respect to claim 1. Moreover, dependent claims 2 and 9 are allowable for at least the reasons set forth above with regard to their respective allowable base claims.

**IV. Rejections of Claims 3-5, 7, 10-12, and 14 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 3-5 and 10-12 under 35 U.S.C. § 103(a) as being unpatentable in view of *Jernberg*, *Tarter*, *Rojewski*, and *IRT*, and the rejection of claims 7 and 14 under 35 U.S.C. § 103(a) as being unpatentable in view of *Jernberg*, *Tarter*, *Rojewski*, and *Atsumi* because a *prima facie* case of obviousness has not been established with respect to these claims.

Claims 3-5, 7, 10-12, and 14 depend from one of independent claims 1 and 8, and thus require all elements of claims 1 and 8. As set forth above, *Jernberg*, *Tarter*, and *Rojewski* fail to teach, suggest, or render obvious each and every element of claims 1 and 8. Moreover, *IRT* and *Atsumi* do not compensate for the deficiencies of *Jernberg*, *Tarter*, and *Rojewski*.

Therefore, a *prima facie* case of obviousness has not been established for claims 3-5, 7, 10-12, and 14 at least due to their dependence and the Examiner should withdraw the rejections of the claims under 35 U.S.C. § 103(a).

**V. Rejection of Claims 17-30 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 17-30 under 35 U.S.C. § 103(a) as being unpatentable in view of *Jernberg*, *McIlroy*, and *Rhodes*

because a *prima facie* case of obviousness has not been established with respect to these claims.

Independent claim 17 recites a method for auditing insurance claims including, among other steps “determining whether to select an insurance claim for audit, the insurance claim including a provider treatment code, based on the provider treatment code, data other then the provider treatment code associated with the claim, and statistical information from past insurance claims,” (emphasis added).

*Jernberg, McIlroy, and Rhodes*, taken alone or in combination, fail to teach, suggest, or render obvious at least these elements of claim 17.

*Jernberg* discloses:

A system and method of evaluating liability among multiple potential responsible parties (PRPs) [and] their insurers [to] support[] mediation and arranging settlements in toxic site cleanup between PRPs and insures. (Col. 11, lines 6-18).

*Jernberg*, however, teach, suggest, or render obvious the claimed screen because *Jernberg* does not disclose “determining whether to select an insurance claim for audit, the insurance claim including a provider treatment code, based on the provider treatment code, data other then the provider treatment code associated with the claim, and statistical information from past insurance claims,” (emphasis added) as recited in claim 17.

*McIlroy and Rhodes* do not overcome the above-noted deficiencies of *Jernberg*. Accordingly, *Jernberg, McIlroy, and Rhodes*, alone or in combination, fail to teach, suggest, or render obvious the step of “determining whether to select an insurance claim for audit, the insurance claim including a provider treatment code, based on the

provider treatment code, data other then the provider treatment code associated with the claim, and statistical information from past insurance claims,” as recited in claim 17. Therefore, the cited art fails to render obvious claim 17. As *prima facie* case of obviousness has not been established for claim 17, the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 23, 29, and 30, although of different scope, recite similar elements to claim 17. Therefore, the rejections of these claims under 35 U.S.C. § 103(a) is not supported by the art of record, for at least the reasons set forth above. Moreover, dependent claims 18-22 and 24-28 are allowable for at least the reasons set forth above with regard to their respective allowable base claims.

#### **VI. Rejection of Claims 31, 32, 34-39, and 41-44 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 31, 32, 34-39, and 41-44 under 35 U.S.C. § 103(a) as being unpatentable in view of *Jernberg*, *Schuler*, and *Wamsley* because a *prima facie* case of obviousness has not been established with respect to these claims.

Independent claim 31 recites a method for managing litigation including, among other steps “providing a user interface . . . the user interface displays a screen comprising: . . . a third section including a list of tasks associated with the insurance claim and status of completion of the tasks,” (emphasis added). *Jernberg* and *Schuler* do not teach or even suggest at least these elements of claim 45. Indeed, the Final Office Action concedes this point on page 12. Instead, the Final Office Action relies upon *Wamsley* to cure tease deficiencies of *Jernberg* and *Schuler*.

*Wamsley* discloses that “[s]election of button icon 181e of menu 181 generates a daily worksheet which lists outstanding ticklers and other prompts, indicating actions that need to be taken to maintain advancement of all open client cases relative to a specified date. The scheduled generation of these ticklers and prompts to provide for the timely and efficient advancement of a client's claim from one phase to the next is further described in connection with FIGS. 3-8. The worksheet presents the clients in alphabetical order with the outstanding action items being indicated adjacent to the client name.” 18:10-20 However, *Wamsley* fails to disclose or suggest “a list of tasks associated with the insurance claim and status of completion of the tasks” at least because *Wamsley* is silent with respect to displaying a status of completion of the task. Indeed, *Wamsley* only displays “outstanding action items.”

For at least these reasons, *Jernberg, Schuler*, and *Wamsley* do not teach or suggest “providing a user interface . . . the user interface displays a screen comprising: . . . a third section including a list of tasks associated with the insurance claim and status of completion of the tasks,” (emphasis added) as recited in claim 31.

Therefore, in view of the mischaracterization of the prior art as set forth above, the Office Action has neither properly determined the scope and content of the prior art, nor properly ascertained the differences between the prior art and the claimed combinations. Accordingly, the Office Action has not clearly articulated a reason as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 31 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claim 38, although of different scope, recite similar elements to claim 31. Therefore, the rejection of this claims under 35 U.S.C. § 103(a) is not supported by the art of record, for at least the reasons set forth above. Moreover, dependent claims 32, 34-37, 39, and 41-44 are allowable for at least the reasons set forth above with regard to their respective allowable base claims.

**VII. Rejection of Claims 33 and 40 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 33 and 40 under 35 U.S.C. § 103(a) as being unpatentable in view of *Jernberg*, *Schuler*, *Wamsley*, and *Ejerhed* because a *prima facie* case of obviousness has not been established with respect to these claims.

Claims 33 and 40 depend from one of independent claims 31 and 38, and thus require all elements of claims 31 and 38. As set forth above, *Jernberg*, *Schuler*, and *Wamsley* fail to teach, suggest, or render obvious each and every element of claims 31 and 38. Moreover, *Ejerhed* does not compensate for the deficiencies of *Jernberg*, *Schuler*, and *Wamsley*.

Accordingly, the Office Action has not clearly articulated a reason as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 33 and 40 at least due to their dependence and the Examiner should withdraw the rejection of the claims under 35 U.S.C. § 103(a).

## CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 19, 2010

By: Philip J. Hoffmann  
Jeffrey A. Berkowitz  
Reg. No. 36,743  
(202) 408-4000

Philip J. Hoffmann  
Registration No. 46,340